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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/815,642

04/02/2004

Kia Silverbrook

HYC007US

9566

24011 7590 08/04/2009
SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

UBER, NATHAN C

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

08/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/815,642	Applicant(s) SILVERBROOK ET AL.	
	Examiner NATHAN C. UBER	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 10, 12 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10, 12 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11 February 2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the RCE filed on 01 June 2009.
2. Claim 1 has been amended.
3. Claims 1-3, 10, 12 and 29 are currently pending and have been examined.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 22 April 2009 has been entered.

Terminal Disclaimer

5. The terminal disclaimer filed on 22 April 2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 7,137,549 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 112

6. The previous rejection of Claim 1 under 35 U.S.C. 112, first paragraph is withdrawn.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious

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at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-3, 10, 12 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. (4,554,446) in view of Lazzouni et al. (U.S. 5,661,506).

Claims 1-3 and 29:

Murphy discloses an inventory control method that uses a combination of machine readable and human readable indicia on product labels and coupons to track inventory, manage pricing, and conduct various incentive promotions electronically using a combination of point of sale machines and computers. (See at least Figures 1 and 2, see also column 4, lines 27-32). Product identification is discussed with reference to the UPC code (see at least column 3, lines 60-66), however Murphy also more broadly discloses bar codes which may be used to identify more than just UPC data and anticipates or at least renders obvious Applicant's added limitation of *uniquely* identifying the "product item." Murphy particularly notes several different types of coupons including coupons disposed on the product itself as well as coupons that require the customer to transmit customer identification data to the product manufacturer. Murphy points out that in situations where coupons require interaction from the customer, many customers cannot be bothered (a sentiment echoed in applicant's specification), so Murphy solved this problem by creating coded forms and ID cards so that the customer can simply transmit requisite personal information electronically by swiping or entering their coded information. The coupon redemption methods are discussed broadly in columns 9 and

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10. Lines 9/18-29, 9/48-61 and 10/22-46 are particularly relevant to applicant's claims directed towards transmission of coupon and customer information as well as submitting electronic forms. The Murphy disclosure explains that coupon fulfillment information is stored by the system, so that when a coupon is recognized by the system, the system can verify whether the stored coupon conditions are met before issuing the benefit (see at least column 10, lines 52-63 and column 11, lines 46-52).

Further with respect to the limitations of claim 1 directed to sensing machine readable code, position data and redemption information, Murphy discloses at least two sensing steps (swipe and scan) as well as receiving and transmitting redemption information as previously discussed. Further the barcode scanning of Murphy inherently requires the generation of position data as this is the basis for successful bar code scanning. The sensing device must identify the position of the registration posts on the bar code before it can interpret the code residing between the posts. Additionally the position of the bar code itself is inherently valuable to the sensing and data gathering step, especially for products or barcode sheets that may have multiple bar codes. However, Murphy does not disclose the narrower interpretation of *interaction data* as may be gleaned from the specification. Lazzouni, in at least column 4, lines 16-17, 25-26, 34-38, 46-50, 57-59 and in Figure 1 discloses generating interaction data based on sensing the position of a scanning device on substrate that is coded with infrared machine readable coordinate code. It would have been obvious to one having ordinary skill in the art at the time of the invention to enhance the Murphy invention by integrating additional coded data into printed labels and coupons since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 10 and 12:

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Murphy does not disclose the limitations of claims 10 and 12. However, Lazzouni in at least in at least column 4, lines 16-17, 25-26, 34-38, 46-50, 57-59 and in Figure 1 discloses generating interaction data based on sensing the position of a scanning device on coded substrate. The *interaction data* includes a digital representation of writing (see at least Figure 1) and movement data (see at least column 4, lines 46-50).

Claims 10, 12 and 29:

With respect to Applicant's newly added limitation in claims 10, 12 and 29, *the coded data further comprises position data identifying a position of the sensing device relative to the coupon*, the cited combination Murphy/Lazzouni discloses this limitation as shown above. The Lazzouni reference discloses a coded surface that is capable of generating interaction data representative of the position of the sensing device relative to the coded surface. Murphy discloses placing coupons on surfaces and using codes printed on surfaces to represent coupons. The combination of the references embraces identifying the location of the sensing device relative to anything printed on the coded surface.

Response to Arguments

- 10.** Applicant's arguments filed 22 April 2009 have been fully considered but they are not persuasive. Applicant argues that Murphy "fails to teach uniquely identifying the product item" despite Murphy's teaching of the use of bar codes to identify products with machine readable codes. Applicant alleges that Examiner's interpretation of "bar code" requires the modification of the Murphy barcode and that such a modification is not obvious unless the prior art suggests the desirability of the modification. Applicant then concludes that Examiner's rejection relies on impermissible hindsight. Examiner does not suggest any modification of the bar code of the Murphy invention. Bar codes are computer readable code that may be used to represent any data. It is not novel to use bar codes to uniquely identify individual items; in fact many inventory systems track items individually. For example, computer equipment inventory systems in university, corporate and government organizations use barcodes to track individual equipment

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issued to individual employees/students. Bar codes are simply coded data. A single code may be used to denote an entire carton of products, or each product may have a unique code. The Murphy teaching of a bar code does not require any modification to teach Applicant's claims to unique codes. Any person of ordinary skill in the art would recognize that a code may be applied to products individually.

11. Regarding Applicant's position that the only proper way to fashion an obviousness rejection is to rely on the 'teaching suggestion motivation' approach; this is not the *only* way to establish a proper obviousness rejection.

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (setting forth test for implicit teachings); In re Eli Lilly & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) (examiner must present convincing line of reasoning supporting rejection); and Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning). MPEP 2144(I).

12. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed

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invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Here, as noted above, Examiner only relies on the bar code teaching of Murphy to teach using a machine readable code to identify a product. No further teaching is necessary to teach Applicant's claim.

13. Applicant also argues that "Murphy still requires matching products and coupons at the point of sale." Examiner points out to Applicant that the breadth of Applicant's claims read on coupon matching during 'point of sale' transactions. Applicant further argues "uniquely identifying the product item in the sensed coded data overcame this problem." Examiner is not sure what problem Applicant is referring to. This argument appears to be incomplete, it is does not persuade Examiner that Applicant's amendments overcome the prior art of record.
14. As Applicant may gather from the rejection above, Examiner interprets the claims to disclose a commonly known coupon/product reconciling method using Hyperlabel technology. Examiner's position is that in light of the near ubiquitous use of bar codes well before Applicant's priority date (as demonstrated by Murphy) and the teaching of Hyperlabel technology by Lazzouni that the combination is obvious because it is merely a combination of old elements in a predictable way with each element performing as it would have separately. The combination of the elements of each prior art reference produces predictable results. Examiner recommends amending the claims so the patentably distinguishable features of Applicant's invention are clearly disclosed. Perhaps Applicant would find an interview helpful.

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Conclusion

- 15.** Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 8:30am-4:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
- 16.** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
- 17.** Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

- 18.** Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building
401 Dulany Street
Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622
2 August 2009

/Arthur Duran/
Primary Examiner, Art Unit 3622